

REMARKS

Claims 1-67 are pending in this application. Claims 1-39 were rejected.

Claim Rejections – 35 U.S.C. § 101

Claims 1, 4 and 5 were rejected under 35 U.S.C. §101. Applicants have amended independent claim 1, from which claims 4 and 5 depend, to indicate that the claimed processes are performed using a data processing system, e.g. a computer, and are within the technological art. *See In re Toma*, 197 U.S.P.Q. 852, 857 (CCPA 1978).

Claim Rejections – 35 U.S.C. § 103

Claims 1-22, 25-26 and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USCIS in view of Stiegemeier et al.

There is a lack of motivation to combine the USCIS with Stiegemeier because the teachings of the two references are incompatible. Stiegemeier teaches a user interface for entering information into a document. Col. 1, Lines 14-17. Stiegemeier teaches specific advantages of this method including separating the entered data from the document template, displaying only data fields selected based on data entered, and allowing varying sizes of entered data. Col. 2, Lines 20-32. USCIS defeats these advantages by requiring that a printed form be used. “All U.S. employers are responsible for completing Form I-9” Page 1 (printout provided by examiner is cut off). In contrast to the teachings of Stiegemeier that entered data should be separated from the document template, the USCIS teaches that various information must be recorded in the form. Page 3. In contrast to the teachings of Stiegemeier that only data fields selected based on data entered are displayed, the USCIS requires that the Form I-9 always be reproduced in full. Page 3. Those teaching makes it impossible to achieve the advantages claimed by Stiegemeier. The teachings of Benelytics and Stiegmeier are at odds on the

characteristics that Stiegemeier teaches are advantages of using his invention. Prior art cannot be combined in a manner that defeats its purpose. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). In the absence of a motivation or suggestion to combine, the rejection should be withdrawn. MPEP § 2143.01. Applicant respectfully requests withdrawal of the obviousness rejections of claims 1-7 and 15-21.

The obviousness rejection should also be withdrawn because applicants have submitted evidence of commercial success and long felt need that traverses the rejection and rebuts the obviousness rejection.

The Declaration of Elaine Morley (“Declaration”) establishes the requirements of commercial success in accordance with MPEP 716.03. The commercial success experienced by the Verification Software of Lookout Services is commensurate in scope with the claimed invention. *See* Declaration at ¶ 13. The commercial success experienced by the Verification Software of Lookout Services is derived from the claimed invention. *See* Declaration at ¶ 14. The commercial success of the Verification Software of Lookout Services is established by sales figures that are adequately defined with respect to market share. *See* Declaration at ¶ 8-12.

The Declaration also establishes the requirements of long felt need in accordance with MPEP 716.04. The problem of checking the accuracy of employment eligibility documentation was identified by at least 1988 as a need of all employers from “Fortune 500 conglomerates to the neighborhood diner” that was recognized by others, including the Wall Street Journal. *See* Declaration at ¶ 3-4. That need was persistent and was not solved by others for at least a decade. *See* Declaration at ¶ 5. The long-felt need is satisfied by the claimed invention. *See* Declaration at ¶ 6-7.

The evidence of commercial success is especially probative because the company that experienced commercial success derived from the claimed invention had no previous business. The evidence of long felt need is especially probative because the need was backed up by fines and recognized in one of the nation's foremost business newspapers. The applicants request that the obviousness rejection be withdrawn in view of the objective evidence of nonobviousness.

Where, as here, such evidence of commercial success is coupled with evidence of long-felt need despite the availability of the elements conjoined in the claimed invention -- which is practically a restatement of section 103, since the need would not have been long felt if its solution had been obvious to those of ordinary skill in the art -- and the evidence showed satisfaction of that need by the claimed invention and its superiority to the prior art, the case becomes highly persuasive.

In re Tiffin, 443 F.2d 394, 170 U.S.P.Q. 88, 93 (CCPA 1971).

Claims 23, 24, 27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USCIS in view of Stiegemeier and further in view of Ghosh et al.

As discussed with respect to the rejections of claims 1-22, 25-26 and 28-29, there is a lack of motivation to combine USCIS with Stiegemeier because the teachings of the two references are incompatible. Prior art cannot be combined in a manner that defeats its purpose. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). In the absence of a motivation or suggestion to combine, the obviousness rejection should be withdrawn. MPEP § 2143.01. Applicant respectfully requests withdrawal of the obviousness rejections of claims 23, 24, 27 and 30.

The obviousness rejection should also be withdrawn because applicants have submitted evidence of commercial success and long felt need that traverses the rejection and rebuts the obviousness rejection.

The Declaration of Elaine Morley ("Declaration") establishes the requirements of commercial success in accordance with MPEP 716.03. The commercial success experienced by

the Verification Software of Lookout Services is commensurate in scope with the claimed invention. *See* Declaration at ¶ 13. The commercial success experienced by the Verification Software of Lookout Services is derived from the claimed invention. *See* Declaration at ¶ 14. The commercial success of the Verification Software of Lookout Services is established by sales figures that are adequately defined with respect to market share. *See* Declaration at ¶ 8-12.

The Declaration also establishes the requirements of long felt need in accordance with MPEP 716.04. The problem of checking the accuracy of employment eligibility documentation was identified by at least 1988 as a need of all employers from “Fortune 500 conglomerates to the neighborhood diner” that was recognized by others, including the Wall Street Journal. *See* Declaration at ¶ 3-4. That need was persistent and was not solved by others for at least a decade. *See* Declaration at ¶ 5. The long-felt need is satisfied by the claimed invention. *See* Declaration at ¶ 6-7.

The evidence of commercial success is especially probative because the company that experienced commercial success derived from the claimed invention had no previous business. The evidence of long felt need is especially probative because the need was backed up by fines and recognized in one of the nation’s foremost business newspapers. The applicants request that the obviousness rejection of claims 8-14 and 22-28 be withdrawn in view of the objective evidence of nonobviousness.

Claims 31-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USCIS in view of Ghosh and further in view of Stiegemeier.

As discussed with respect to the rejections of claims 1-22, 25-26 and 28-29, there is a lack of motivation to combine USCIS with Stiegemeier because the teachings of the two references are incompatible. Prior art cannot be combined in a manner that defeats its purpose.

In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). In the absence of a motivation or suggestion to combine, the obviousness rejection should be withdrawn. MPEP § 2143.01. Applicant respectfully requests withdrawal of the obviousness rejections of claims 31-39.

The obviousness rejection should also be withdrawn because applicants have submitted evidence of commercial success and long felt need that traverses the rejection and rebuts the obviousness rejection. As discussed above, applicants have established that the objective evidence of nonobviousness outweighs any evidence of obviousness.

SUMMARY


In light of the above remarks Applicants respectfully submit that the application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as below.

Applicants believe no fees are due. However, should the Commissioner deem any fees are due, including any fees for additional extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and further authorize the Commissioner to debit any additional fees due, or to credit any overpayments, to Baker Botts L.L.P. Deposit Account Number **02-0383**, Order Number **075006.0103**.

Respectfully submitted,

Baker Botts L.L.P.

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